

Application No.: 10/698,676
Amendment Dated: November 7, 2005
Reply to Office Action of: July 5, 2005

REMARKS

Claims 1-26 are currently pending in this application. By this Amendment, claims 1, 12, and 24 are amended.

Objection

Claim 12 was objected to because line 4 of the claims was incomplete. Claim 12 has been amended to remedy this informality. The same informality has been corrected in claim 24. Withdrawal of this objection is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 3-8, 10, 12-20, and 22-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,231,591 (Desai). Applicant respectfully traverses this rejection.

The Examiner asserts with regard to claims 12, 24, and 26 that the device of Desai includes an imaging apparatus 304 that is "sized for insertion into a rectum of a patient to generate one or more images of a prostate gland, the imaging apparatus formed with a hole; a needle positioned through the hole". The Examiner refers to column 19, lines 67 – column 20, lines 11 and Figure 25 as the basis for this assertion. Applicant respectfully disagrees and asserts that the imaging apparatus of Desai 304 does not include a hole through which a needle is positioned.

Figure 25 is first discussed beginning at column 16, line 58. The endoscopic surgical instrument assembly 302 of Figure 25 is discussed and is said to include three major sub-assemblies: the housing 308, a treatment device assembly 310, and the endoscope 304. The treatment device assembly 310 is further discussed beginning at column 17, line 18; and includes the electrode/needle 306 (seen in Figures 25 and 26). The endoscope 304, which the Examiner asserts could be considered the imaging apparatus of Applicant's claims, includes the endoscope probe 316 (also seen in Figures 25 and 26). As can be seen from Figures 25 and 26, the needle 306 does not exit from the endoscope 304 or its component, the endoscope probe 316.

Because Desai does not disclose an apparatus that includes "a needle positioned through the hole of the imaging apparatus", it does not anticipate claims 12, 24, 26, or any of the claims dependent thereon. Furthermore, at least because Desai does not disclose a system or apparatus

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as claimed, it cannot be inherently capable of performing the recited method claims of claims 1, 3-8, and 10.

In light of the comments offered above, Applicant respectfully requests that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

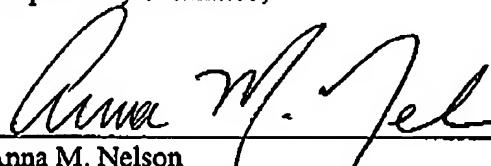
Claims 2, 9, 11 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,231,591 (Desai) in view of U.S. Patent No. 6,365,164 (Schmidt). Applicant respectfully traverses this rejection.

Applicant respectfully asserts that neither Desai, Schmidt, nor the combination thereof provide or suggest all the elements of the independent claims upon which these claims are dependent, and therefore these claims are not obvious in light of this combination. Applicant respectfully requests that this rejection be withdrawn in light of the comments offered above.

In view of the foregoing amendments and remarks, it is believed that the application is now in condition for allowance and notice of same is respectfully requested. The Examiner is respectfully requested to contact the undersigned by telephone at 763.505. 0409 or by E-mail at anna.m.nelson@medtronic.com with any questions or comments. Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 13-2546.

Respectfully submitted,

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